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| 09/916,358 | 07/27/2001 | David B. Loeper | FINANCE 3 | 9160 |

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| EXAMINER |
|---|
| CAMPEN, KELLY SCAGGS |

| ART UNIT | PAPER NUMBER |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/916,358 | LOEPER, DAVID B. | |
| | Examiner | Art Unit | |
| | Kelly Campen | 3691 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *20 November 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) *20-26* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *2/27/2006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### *Election/Restrictions*

Newly submitted claims 20-26 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries); and, the prior art applicable to one invention would not likely be applicable to another invention Therefore there would be a serious search and examination burden if restriction were not required.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 20-26 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. (US 6021397) in view of Bierwirth (Investing for Retirement: Using the Past to Model the Future, 1994).

Specifically as to claim 1, Jones et al. disclose the invention substantially as claimed as in a method for evaluating financial plans (Abstract) the steps of: receiving from a user financial plan information, comprising a predetermined initial value of an investment (col. 18, lines 27-29), at least one predetermined contribution amount at a predetermined contribution time (col. 18, line 21 and col. 18, lines 43-48), at least one predetermined withdrawal amount at a predetermined withdrawal time subsequent to the predetermined contribution time (col. 22, lines 56-60) and a plan duration (col. 17, line 36-43 and col. 18, lines 27-28); updating the second changed investment value based on a selected contribution or withdrawal amount corresponding to the length of the second time interval in accordance with the financial plan (see col. 19 lines 25-32); and presenting calculated investment values using results of said steps (col. 20, lines 7-30) but does not specifically disclose the detail of simulating historical performance of a portfolio to analyze financial plans. Bierwirth discloses these particular features as follows: selecting a first historical commencement date for a simulation of performance of a financial plan consistent with financial plan information (Page 3, lines 24-26); using historical market data commencing from said first historical commencement date, calculating the changes in the predetermined initial value of an investment for each time period in one or more series of successive historical time periods including allowing for said predetermined contribution amount and said predetermined withdrawal amount continuing until an expiration of the plan duration (Page 3, lines 35-38); and selecting a plurality of second historical commencement dates and repeating the foregoing steps of calculation commencing with each of said second historical commencement dates (Page 3, lines 29-32).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the financial plan analysis of Jones with the historical analysis of Bierwirth because of the improved performance resulting from this historical approach. Bierwirth specifically sets out these benefits as follows. Bierwirth describes problems with unrealistic assumptions of traditional financial plans at the last paragraph of page 1 and describes the solution to this problem as using the historical investment experience of others to produce more realistic and useful retirement modeling. See particularly the Conclusion at page 6 of Bierwirth.

Specifically as to claims 2, 9 and 15, Jones et al. disclose the presentation of results at col. 4, lines 24-34 and col. 11, lines 7-10.

Specifically as to claims 3, 10 and 16, Jones et al. disclose multiple asset categories and distinct historical data at Fig. 4 and col. 12, line 54 to col. 13, line 41.

Specifically as to claims 4, 11 and 17, comparison of results of calculation to a goal would be obvious to assess performance of the modeled financial plan.

Specifically as to claims 5, 12 and 18, Jones et al. disclose adjustment for taxes at Fig. 3 and col. 8, lines 1-13

Specifically as to claims 6, 13 and 19, Jones et al. teach the entry of initial investment values and allocation to asset categories at col. 5, line 50 to col. Col. 7, line 10.

Specifically as to claim 7, see the discussion of plural runs in the rejection of claim 1.

Specifically as to claims 8 and 14, see the discussion of claim 1; Jones et al. disclose system and storage media at col. 4, line 60 to col. 5, line 49.

***Response to Amendment***

The Declaration under 37 CFR 1.132 filed 11/20/2006 is insufficient to overcome the rejection of claims 1-19 based upon 35 USC 103 as set forth in the last Office action because: facts presented are not germane to the rejection at issue. In addition, it refer(s) only to the system described in the above referenced application and not to the individual claims of the application. Thus, there is no showing that the objective evidence of nonobviousness is commensurate in scope with the claims. See MPEP § 716.

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

***Response to Arguments***

Applicant's arguments filed 11/20/06 have been fully considered but they are not persuasive. Specifically, the obviousness rejection does not rely on the Examiner's expert testimony as indicated in the rejection based on Jones et al. in view of Bierwirth. In addition, it is noted that no Official Notice was given in the prior office action. As such, Examiner notes applicant's Declaration and evidence to ordinary skill in the art, but the arguments are moot as no Official Notice was relied upon in the rejection as set in the above rejection the pending claims (see above).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so

long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, *Bierwirth* describes problems with unrealistic assumptions of traditional financial plans at the last paragraph of page 1 and describes the solution to this problem as using the historical investment experience of others to produce more realistic and useful retirement modeling. See particularly the Conclusion at page 6 of Bierwirth. Additionally, an invention is likely obvious if a person of ordinary skill in the art can implement a predictable variation, and would see the benefit of doing so.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly Campen whose telephone number is (571) 272-6740. The examiner can normally be reached on Tuesday and Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kelly Campen

ALEXANDER KALINOWSKI
SUPERVISORY PATENT EXAMINER